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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,469	12/08/2003	Heribert Lorenz	101216-38	2884
27387	7590	10-05/2004	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			ELHILO, EISA B	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/730,469

Applicant(s)

LORENZ ET AL.

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1 This action is responsive to the amendment filed on July 16, 2004.

2 Objection to claim 1 is withdrawn because of the applicant's amendment.

3 The rejection of claim 1 under nonstatutory double patenting over claim 1 of the copending Applications No. 10/465278, 10/755744 and 10/642917, is withdrawn because of the applicant's amendment in which the claim requires at least one developing and/or coupling substance selected from para-phenylenediamine compounds to be in the dyeing composition.

Also the rejection of claim 1 under nonstatutory double patenting over claim 1 of the copending Applications No. 10/465304 and 10/465078, is withdrawn because of the applicant's amendment in which the claim requires at least one developing and/or coupling substance selected from 3-(N-methyl-N-hydroxyethyl amino)-phenol, 3-morpholinophenol, 3-(N-hydroxyethyl amino)-phenol and 3-(N-hydroxypropyl amino)-phenol compounds to be in the dyeing composition.

4 The rejections of claim 1 under 35 U.S.C. 102(b) as being anticipated by Henkel KGAA[HENK] (DE 20017642 U1), Tamura et al. (US 5,015,260), Audousset et al. (US 5,578,087), Junino et al. (US 4,865,619), Konrad et al. (US 4,883,656) and Golinski et al. (DE 19834657 C1) are withdrawn because of the applicant's amendment.

### NEW GROUND OF REJECTION

#### *Claim Rejections - 35 USC § 103*

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Audousset et al. (US 5,578,087) in view of Rose et al. (US 4,003,699).

Audousset et al. (US' 087) teaches a hair dyeing composition comprising at least one benzimidazole component combined with developing agents (oxidation bases) of 3-chloro-p-aminophenol (see col. 3, line 55) and para-phenylenediamine (see col. 2, lines 49-67).

Although Audousset et al. (US' 078) teaches a hair dyeing composition comprising oxidation bases of 3-chloro-p-aminophenol and para-phenylenediamine, the reference does not teach the dyeing compounds as claimed in claim 1 b). However, the reference teaches that the dyeing composition can also contains other couplers customarily used in dyeing composition for keratinous fibers (see col. 5, lines 27-29).

Rose et al. (US' 699) teaches in analogous art of hair dyeing formulation, a composition comprising 3-morpholinophenol (see col. 9, line 68).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to modify the dyeing composition of Audousset et al. (US' 078) by incorporating the 3-morpholinophenol as taught by Rose et al. (US' 699) to make such a composition with the reasonable expectation of success. Such a modification would be obvious because the primary reference of Audousset et al. (US' 078) clearly suggests that other customarily used couplers may be included in the dyeing composition (see col. 5, lines 27-29). The secondary reference of Rose et al. (US' 699) clearly teaches that 3-morpholinophenol is among the suitable coupling compounds to be used in the dyeing composition (see col. 9, lines 42-68), and, thus, a person of the ordinary skill in the art would be motivated to incorporate 3-morpholinophenol as a customarily used coupler in the dyeing of

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Audousset et al. (US' 078) and would expect such a composition to have similar properties to those claimed in the absence of contrary.

*Conclusion*

6 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo  
September 23, 2004



Mark Kopec  
Primary Examiner